



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Attorney Docket No. ACY33464 D1)

RECEIVED
AUG 21 2003
TECH CENTER 1600/2908
#10
VC
03

In re Application of:

JEREMY I. LEVIN *et al.*

Filed: 11/13/2001

For: ALKYNYL CONTAINING HYDROXAMIC
ACID COMPOUNDS AS MATRIX METALLO-
PROTEINASE AND TACE INHIBITORS

) Appln. No.: 10/055,502
) Confirmation No.: 8971
) Customer No.: 25291
) Group Art Unit: 1625
) Examiner: D. Margaret Seaman

) Paper No.: 10

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE

Dear Sir:

Responsive to the Office action mailed May 16, 2003 in the above-referenced patent application, please consider the below remarks in a favorable light:

REMARKS

Reconsideration of this application is respectfully requested.

Applicants elected Group II wherein Y is heteroaryl. The Examiner has made the restriction requirement final. As such, Applicants will amend the claims in due course once the extent of allowable subject matter has been determined.

The Examiner has rejected Claims 1, 2 and 5-7 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement for reasons set forth in the Office action on page 2. Applicants respectfully traverse the rejection for the following reasons.

In effect, the restriction requirement has artificially carved the elected Y group out of the claims, purely as a means of making examination easier. Consequently, a proper determination of the written description requirement should focus on the complete application including the original claims. If the complete application is considered, it will be evident that the specification, as filed, adequately describes the invention taken as a whole and the generic structure wherein Y is a heteroaryl.

A skilled chemist would recognize from the examples illustrating numerous representative compounds of the claimed genus that Applicants had possession of all members of the genus in